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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,681	09/18/2003	Leonard Robert Speiser	2043.093US1	8255
21186	7590	04/18/2006	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402			O'CONNOR, GERALD J	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/666,681

**Applicant(s)**

Speiser et al.

**Examiner**

O'Connor

**Art Unit**

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on February 2, 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-22 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on September 18, 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>20060202</u>  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Preliminary Remarks***

1. This Office action responds to the amendment and arguments filed by applicant on February 2, 2006 in reply to the previous Office action on the merits, mailed November 16, 2005.
2. The amendment of claims 15-22 and cancellation of claims 1-14 and 23-34 by applicant in the reply filed February 2, 2006 are hereby acknowledged.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 15-22 are rejected under 35 U.S.C. 102(a) as being anticipated by Spiegel et al. (US 6,466,918).

Spiegel et al. disclose a method of providing listing recommendations to users of a network-based commerce system including a plurality of listings 120 arranged in a plurality of divisions 130, the method including: identifying a division 110 of the plurality of divisions 130 based on user interaction with the network-based commerce system; identifying at least one frequently used search term associated with the identified division 110; and providing a link to the user to listings 120 associated with each frequently used search term 110. See, in particular: col. 4, lines 43-67; col. 6, lines 5-60; col. 7, lines 6-67; col. 8, lines 33-59; and, Figure 1A.

Regarding claim 16, the method of Spiegel et al. includes communicating a web page to the user including a hyperlink to the listings associated with each frequently used search term. See, in particular, column 4, lines 61-65.

Regarding claim 17, in the method of Spiegel et al. the listings associated with each frequently used search term are listings that would be located if the user conducted a search of the network-based commerce system using each frequently used search term.

Regarding claim 18, in the method of Spiegel et al. the at least one frequently used search term is ranked in one of an ascending and descending order according to a number of occurrences of listings in a division associated with the at least one frequently used search term.

Regarding claim 19, the method of Spiegel et al. inherently includes periodically adding new listings and removing terminated listings prior to determining the number of listings in each

division associated with each frequently used search term so that the ranking is dependent upon supply and demand for the listings.

Regarding claim 20, the method of Spiegel et al. includes searching the network-based commerce system using at least one frequently used search term when the user selects the link.

Regarding claim 21, in the method of Spiegel et al. the at least one frequently used search term is displayed according to rank in one of an ascending and descending order.

Regarding claim 22, in the method of Spiegel et al. one or more frequently used search terms are assigned to each of the plurality of divisions, the divisions being defined by categories.

### *Response to Arguments*

5. Applicant's arguments filed Feb. 2, 2006 have been fully considered but are not persuasive.

6. Regarding the argument that Spiegel et al. fail to disclose "identifying at least one frequently used search term associated with the identified division," Spiegel et al. indeed disclose "identifying at least one frequently used search term associated with the identified division," for example, the frequently-used search term "Olympics" associated with the second identified division under "Featured Categories" in Figure 1. See, in particular, column 7, lines 6-67.

7. Regarding the argument that Spiegel et al. fail to disclose "providing a link to the user to listings associated with the at least one frequently used search term," Spiegel et al. indeed disclose "providing a link to the user to listings associated with the at least one frequently used

search term,” since the items/listings shown in Figure 1 are hyperlinks. See, in particular, column 4, lines 61-67.

8. Regarding the argument that the Spiegel et al. reference is too complex and that applicants “cannot be expected to guess or infer what or how the Examiner is interpreting and relying on Spiegel et al.,” the Spiegel et al. reference is scarcely complex, and shows exactly the same invention as claimed by applicant. However, as a courtesy to applicant, and in the interest of expediting prosecution, the rejection has been clarified to hopefully facilitate applicant’s understanding of the grounds of rejection, by pointing out with specificity the particular parts of the reference that are most pertinent to the rejected claims.

### *Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to the disclosure.

10. Applicant’s amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the

date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Alexander Kalinowski, can be reached at **(571) 272-6771**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (571) 273-8300.** Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

April 14, 2006

 4/14/06

Gerald J. O'Connor  
Primary Examiner  
Group Art Unit 3627